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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR919980105001 (8708-1331)

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Application Number

09/133,960

Filed

August 14, 1998

First Named Inventor

L'Oréal et al.

Art Unit

2623

Examiner

Mark V. Tran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed
(Form PTO/SB/068)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.
Registration number acting under 37 CFR 1.34 43,958



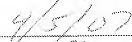
Signature

Frank V. DeRosa

Typed or printed name

816-632-8668

Telephone number



Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Joshi et al

Examiner: Hai V. Tran

Serial No: 09/133,960

Group: Art Unit 2623

Filed: August 14, 1998

Docket: YOR919980195US1 (8728-139)

For:

**WIRELESS INFORMATION TRANSFER AND
INTERACTIVE TELEVISION SYSTEM**

Statement in Support of Pre-Appeal Brief Request for Review

This paper is being filed in support of Applicants' 2nd Pre-Appeal Brief Request for Review. A Notice of Appeal has been filed herewith in response to a Final Office Action mailed on January 5, 2007, resulting from the Examiner's reopening of prosecution (via an Office Action mailed on 7/13/06) in response to Applicants' initial filing of a Notice of Appeal and Pre-Appeal Brief Request for Review on March 17, 2007. Applicants respectfully contend that the claim rejections set forth in the Final Office Action are clearly erroneous as a matter of fact and/or law.

In fact, the Examiner asserts essentially the same obviousness rejections that were previously considered and seemingly rejected by the Panel of Examiners in the 1st Pre-Appeal Brief Review. It is unclear why the Examiner is maintaining these rejections once again and why Applicants are once again being forced to address the same issues by this 2nd Notice of Appeal and Request for Pre-Appeal Brief Review. At the very least, the obviousness rejections of independent claims 1 and 36 are improper as a matter of law and fact for at least the same reasons previously asserted and considered by the Panel.

To reiterate, with respect to claim 1, Applicants respectfully submit that the combination of Krusher and Lancelot does not disclose or suggest various features of claim 1, for example:

... a first communication system, operatively coupled to a television set, comprising a first RF transceiver unit and a first data processing unit for generating at least one information signal ... a wireless signal transfer network for wirelessly transferring signals including the at least one information signal ... a second communication system operatively coupled to the wireless transfer network, comprising a second RF transceiver unit and a second data processing

unit for receiving and processing the at least one information signal and ... generating at least one return information signal and providing the at least one return information signal to the wireless signal transfer network, *wherein the at least one information signal and the at least one return information signal are independently transmitted from a television signal.*

The Final Office Action fails to present sound legal reasoning to support the obviousness rejection of claim 1 based on the combination of Krisbergh and Lancelot. The primary reference Krisbergh is directed to a system and method for providing access to the Internet through a cable television distribution system (see, Col. 1, lines 10-13). The Examiner acknowledges, at the very least, that Krisbergh does not disclose a return signal is independently transmitted from a TV signal (see, e.g., page 8 of the Final Action).

The Examiner relies on Lancelot in this regard. In particular, Examiner contends on page 9 of the Final Action, without any supporting explanation, that Lancelot discloses (FIG. 2, Col. 4, lines 25 – COL. 5, line 17) that return data is independently transmitted from a TV signal (see page 9 of the Final Action). It is respectfully submitted that the Examiner's reliance on Lancelot is misplaced.

To begin, Lancelot discloses in FIG. 2 a primary station (105) which is a shared (trunked) device in a central location that provides services to many subscribers and users. The primary station (105) sends data to a plurality of secondary stations (110) that are located within the users' homes (including telephones, PCs, video displays, etc.) via a HFC (hybrid fiber coaxial) communications system (103). Lancelot discloses that a TV signal is transmitted with other signals (via combiner (104)) on the HFC communications system (103), and that CACS (cable access signaling) is used for transmission and reception of data, etc. over communication channel (103) at radio frequencies compatible with cable television CATV networks (see, Col. 4, lines 45-66, and Col. 5, lines 45-55).

In this regard, Lancelot is yet another example of using communications over low bandwidth cable networks, which the Applicants have distinguished from the claimed inventions (see, e.g., pages 1 and 2 of Applicants' specification). In this regard, Lancelot is essentially irrelevant and actually teaches away from the claimed inventions

Moreover, the Examiner has not demonstrated proper motivation for combining Krisbergh and Lancelot. The Examiner contends that it would have been obvious to modify Krisbergh to Lancelot. Although not clear, it appears that Examiner contends that it would have been obvious to modify Krisbergh with Lancelot's purported teaching of independently transmitting a data signal downstream independent of a TV signal.

However, it is axiomatic that if a proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See, MPEP 2143.01, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1964). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Here, Krisbergh discloses a method of transmitting data to a terminal by inserting the data signal in a VBI of the TV video signal for purposes of displaying the data on a display device associated with the terminal. This is the basis of the Krisbergh protocol and Krisbergh cites advantages to such downstream data transmission (see, e.g., Col. 8, lines 1-34). Examiner's proposed modification of Krisbergh (not including data in the VBI of the TV signal) would fundamentally change the principle and purpose of the Krisbergh system, which renders the obviousness rejections deficient on their face.

The Examiner contends on Page 4 of the Final Office Action that:

the combination of Krisbergh and Lancelot would not change the principle and purpose of the Krisbergh System because the change would further increase the amount of data that Krisbergh system can be transmitted downstream on separate/independent channel.

However, this contention misses the point and fails to address Applicants' above argument - Examiner's proposed modification of Krisbergh (not including data in the VBI of the TV signal) would fundamentally change the principle and purpose of the Krisbergh system, which renders the obviousness rejections deficient on their face. Again, Lancelot discloses that a TV signal is transmitted with other signals (via combiner (104)) on the HFC communications

system (103), and that CACS (cable access signaling) is used for transmission and reception of data, etc. over communication channel (103) at radio frequencies compatible with cable television CATV networks (see, Col. 4, lines 45-66, and Col. 5, lines 45-55. In this regard, Lancelot is yet another example of using communications over low bandwidth cable networks, which is distinguished from the claimed inventions

Applicants respectfully submit that claim 36 is patentable and non-obvious over the combination of Krisbergh, Lancelot, and Yasuki for reasons similar to that given above for claim 1. Indeed, Yasuki does not cure the deficiencies of Krisbergh and Lancelot. Accordingly, for at least the above reasons, claims 1 and 36 (and all claims that depend therefrom) are patentable over the cited art of record.

Drawing Objections

The drawing objections set forth in the Final Office Action are wholly erroneous and simply devoid of any legal basis. As can be readily gleaned from the assertions on pages 4 and 5 of the Final Office Action, the Examiner unreasonably demands that the Applicants provide a modification of FIG. 2 showing two separate communication units (104), with a 1st unit (104) being coupled to the Satellite transceiver and to a TV display (102), and a second unit (104) being coupled to the satellite transceiver and the server (110).

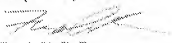
However, this requirement is neither reasonable nor legally justifiable given that **FIG. 1 already depicts what the Examiner is requesting.** Indeed, FIG. 1 already illustrates two separate communication units (104), with a 1st unit (104) being coupled to the Satellite transceiver (106a) and to a TV display (102), and a 2nd unit (104) being coupled to the satellite transceiver (106a) and the server (110). Notwithstanding that the basis for this drawing objection is somewhat unintelligible (see page 4 of the Final Action), there is simply no reason to force the Applicants, especially at this late stage of prosecution, to provide duplicate drawings or otherwise add new drawing with superfluous illustrations which illustrate that what is already shown.

As discussed on page 11, et seq. of Applicants' specification, FIG. 2 is an exemplary embodiment of a communication unit (104) for providing interactive television functions and that (as stated on page 15, lines 4-6), the remote communication unit (104) connected to the

service 110 preferably includes identical components as the communication unit at the user station to be connected to a television set.... In other words, Applicants teach that the embodiment of the unit (104) in FIG. is applicable to both units (104) depicted in FIG. 1.

In short, based on the above, it is clear that the Examiner's drawing objections are legally improper and would result in duplicate or otherwise superfluous illustrations that are simply not necessary. As such, Applicants respectfully request that the Panel withdraw the drawing objections. In the event that the Panel finds the claim rejections and drawing objections to be viable, but that the drawing objections are not appealable, Applicants request that the Appeal go forward with the claim rejections and that the drawing objections be severed so that Applicants can file a Petition to with the Commissioner to withdraw the drawing objections, if desired..

Respectfully submitted,


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